S/N 10/777,260 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Zachary A. Garbow	Examiner: Melvin H Pollack
Serial No.: 10/777,260	Group Art Unit: 2445
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	Docket: ROC920030353US1

Title: Computer With a Personal Digital Assistant

APPEAL BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents
P.O. Box 1450
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This brief is presented in support of the Notice of Appeal filed on June 12, 2009, from the Final Rejection of claims 1-6 and 21-23 of the above-identified application, as set forth in the Final Office Action mailed on March 12, 2009.

Please charge $540.00 to Deposit Account 09-0465 to cover the fee for filing an appeal brief. Please charge any additional fees or credit overpayment to Deposit Account 09-0465. Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-6 and 21-23.

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1. Real Party in Interest

The real party in interest, in addition to the inventor, Zachary A. Garbow, is the assignee, International Business Machines Corporation, a corporation organized and existing under and by virtue of the laws of the State of New York, and having an office and place of business at New Orchard Road, Armonk, New York 10504.

2. Related Appeals and Interferences

There are no other prior or pending appeals, interferences, or judicial proceedings, which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision.

3. Status of Claims

On June 12, 2009, appellant appealed from the final rejection of claims 1-6 and 21-23 made in the Final Office Action dated March 12, 2009. Claims 7-20 were canceled without prejudice or disclaimer. Finally rejected claims 1-6 and 21-23 on appeal are set forth in the Claims Appendix.

4. Status of Amendments

Subsequent to the Final Office Action dated March 12, 2009, appellant did not file any amendments.

5. Summary of Claimed Subject Matter

As described, by way of example and not of limitation, at page 2, lines 8-15 of appellant's specification and as illustrated, by way of example and not of limitation, at Fig. 1, elements 100, 102, 108, 110, at Fig. 2, elements 100, 102, 108, 205, and 212, and at Fig. 6, elements 605, 610, and 615, "[a determination is made] whether a window meets a criteria. If the window meets the criteria, the window is sent to a personal digital assistant. If the window does meet the criteria, then the window is sent to a computer display. In an embodiment, the personal digital assistant is attached via a hinge to the computer and is capable of rotating via the hinge between a closed position atop a lid portion of the computer to an open position side-by-side with the lid portion. In this way, the display of the computer is viewable simultaneously with the personal digital assistant."

With reference to claim 1, an embodiment of the invention comprises a method, which is described, by way of example and not of limitation, in the specification, at page 2, line 8, at page 4, lines 11-28, at page 5, lines 1-20, at page 8, lines 3-12, at Fig. 3, elements 100, 108, 301, 301A, 301B, 301C, 301D, 302, 370, and 372, at Fig. 4, elements 400, 405, 410, 415, and 420, at Fig. 5, elements 500, 505, 510, and 599, and at Fig. 6, elements 600, 605, 610, 615, and 699.

With further reference to claim 1, the method comprises determining whether data meets a criteria, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With further reference to claim 1, the method comprises if the data does not meet the criteria, sending the data to a computer display of a computer, wherein the computer comprises a base portion and a lid portion, wherein the base portion and the lid portion of the computer are attached via a first hinge, wherein the base portion and the lid portion of the computer rotate via the first hinge between a first closed position and a first open position, and wherein the lid portion comprises the computer display, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-14, at page 3, lines 9-27, at page 4, lines 1-10, at page 11, lines 14-22, at page 12, lines 1-7, at Fig. 1, elements 100,

102, 104, and 106, at Fig. 2, elements 100, 102, 104, and 205, and at Fig. 6, elements 605 and 615.

With further reference to claim 1, the method comprises if the data meets the criteria, sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-15, at page 3, lines 9-27, at page 4, lines 1-10, at page 11, lines 14-26, at Fig. 1, elements 100, 102, 104, 108, and 110, at Fig. 2, elements 100, 102, 108, 205, and 212, and at Fig. 6, elements 605 and 610.

With reference to claim 2, the determining further comprises determining whether the data comprises an instant messaging application window, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With reference to claim 3, the determining further comprises determining whether the data comprises a calculator application window, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With reference to claim 4, the determining further comprises determining whether the data comprises a calendar application window, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With reference to claim 5, the determining further comprises determining whether the data comprises a media player application window, which is described, by way of example

and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With reference to claim 6, the determining further comprises determining whether the data comprises an e-mail application window, which is described, by way of example and not of limitation, in the specification, at page 2, lines 8-10, at page 11, lines 14-22, and at Fig. 6, element 605.

With reference to claim 21, the method further comprises instructing a power supply of the computer to supply power to an input device of the computer, which is described, by way of example and not of limitation, in the specification, at page 10, lines 25-27, at page 11, lines 1-6, at Fig. 1, elements 100 and 108, at Fig. 2, elements 100, 108, and 210, at Fig. 3, elements 100, 108, 210, and 372, and at Fig. 5, element 505.

With further reference to claim 21, the method further comprises receiving input at the personal digital assistant from the input device of the computer, which is described, by way of example and not of limitation, in the specification, at page 10, lines 25-27, at page 11, lines 1-12, at Fig. 1, elements 100 and 108, at Fig. 2, elements 100, 108, and 210, at Fig. 3, elements 100, 108, 210, and 372, and at Fig. 5, elements 505 and 510.

With reference to claim 22, the method further comprises determining that data has been changed at the personal digital assistant, which is described, by way of example and not of limitation, in the specification, at page 10, lines 10-13, at Fig. 1, element 108, at Fig. 2, element 108, at Fig. 3, elements 108 and 372, and at Fig. 4, element 405.

With reference to claim 22, the method further comprises determining whether the computer is powered on, which is described, by way of example and not of limitation, in the specification, at page 10, lines 12-14, at Fig. 1, elements 100 and 108, at Fig. 2, elements 100 and 108, at Fig. 3, elements 100, 108, and 372, and at Fig. 4, element 410.

With reference to claim 22, the method further comprises if the data has been changed at the personal digital assistant and the computer is powered on, synchronizing the data with the computer, which is described, by way of example and not of limitation, in the specification, at page 10, lines 11-18, at Fig. 1, elements 100 and 108, at Fig. 2, elements 100 and 108, at Fig. 3, elements 100, 108, and 372, and at Fig. 4, elements 405, 410, and 415.

With reference to claim 23, the method further comprises sending input from an input device in the base portion to the personal digital assistant, which is described, by way of example and not of limitation, in the specification, at page 10, lines 25-27, at page 11, lines 1-12, at Fig. 1, elements 100, 104, and 108, at Fig. 2, elements 100, 104, 108, and 210, at Fig. 3, elements 100, 108, 210, and 372, and at Fig. 5, elements 505 and 510.

6. Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1, 4, 6, and 23 are unpatentable under 35 U.S.C. 103(a) over Singleton (US 2004/0019724), hereinafter "Singleton," in view of Ramakesavan (US 2003/0065734), hereinafter "Ramakesavan," and Duquette (US Patent Number 6,667,877), hereinafter "Duquette."

2. Whether claims 2 and 5 are unpatentable under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Chen (US Patent Publication Number 2004/0148419), hereinafter "Chen."

3. Whether claim 3 is unpatentable under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Hawkins (US Patent Number 6,957,397), hereinafter "Hawkins."

4. Whether claims 21-22 are unpatentable under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Huber (US Patent Number 7,197,584), hereinafter "Huber."

7. Argument

A) The Applicable Law

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

> Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Furthermore, claims must be interpreted in light of the specification, claim language, other claims and prosecution history. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987), *cert.*

denied, 481 U.S. 1052 (1987). At the same time, a prior patent cited as a § 103 reference must be considered in its entirety, "*i.e.* as a *whole*, including portions that lead away from the invention." *Id.* That is, the Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. § 103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Finally, the Examiner must avoid hindsight. *Id.*

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. But, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

B) Discussion of the Rejections

1. Claims 1, 4, 6, and 23 are rejected under 35 U.S.C. 103(a) over Singleton (US 2004/0019724), hereinafter "Singleton," in view of Ramakesavan (US 2003/0065734), hereinafter "Ramakesavan," and Duquette (US Patent Number 6,667,877), hereinafter "Duquette."

Claim 1

Claim 1 recites: "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the

screen of the personal digital assistant is not viewable simultaneously with the computer display," which is not taught or suggested by Singleton, Ramakesavan, Duquette for the reasons argued below.

In contrast to claim 1, the Singleton PDA 102 is attached to a docking port 120 in the palm rest 118 of the body 112, as illustrated by Singleton at Fig. 1 and as described by Singleton at [0014] and [0015], so the Singleton PDA 102 is not attached via a hinge to a lid, and the Singleton PDA 102 does not rotate, so Singleton teaches away from "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display," as recited in claim 1.

In contrast to claim 1, the Ramakesavan PDA display 620 in Figure 6 "operat[es] as an integrated unit" with the laptop display 610 (Ramakesavan at [0033]), so the Ramakesavan PDA display 620 is not attached via a second hinge to the laptop display 610 and does not rotate "between a second closed position atop the lid portion of the computer" as recited in claim 1 because the Ramakesavan PDA display 620 is never atop the Ramakesavan laptop display 610. Thus, Ramakesavan teaches away from claim 1.

In further contrast to claim 1, Fig. 5A of Ramakesavan illustrates a detached PDA 500 having a display 510 and a housing 520 attached via a hinge, as described by Ramakesavan at [0032]. Thus, Ramakesavan teaches away from "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in

the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display," as recited in claim 1 because the Ramakesavan display 510 and housing 520 of the detached PDA 500 rotate about each other via a hinge and not "between a second closed position atop the lid portion of the computer," as recited in claim 1 because Fig. 5A of Ramakesavan illustrates the PDA 500 detached from the Ramakesavan laptop, and the hinge that attaches the PDA display 510 and the PDA housing 520 is attaching the display and housing components of the PDA 500 to each other and not attaching the Ramakesavan detached PDA 500 to a laptop.

No suggestion exists to combine Duquette with Ramakesavan because to do so would render Ramakesavan inoperable for its intended purpose. The purpose of Ramakesavan, as described at [0023], is to "selectively [couple]" "The PDA" "to the computer to allow operation of the processor of the PDA and the processor of the computer as single multi-processor computer." If Ramakesavan were modified with Duquette, the Duquette "second monitor screen 70" (Duquette at column 5, lines 31-33 and Fig. 3) would replace the Ramakesavan PDA display 620 (Ramakesavan at Fig. 6 and [0033]). Once Ramakesavan is modified so that the Ramakesavan PDA is replaced with the Duquette "second monitor screen 70," the modified Ramakesavan no longer has a PDA, so the modified Ramakesavan no longer allows "operation of the processor of the PDA and the processor of the computer as single multi-processor computer," (Ramakesavan at [0023]), so the function, purpose, and operability of Ramakesavan is destroyed. Thus, no suggestion exists to modify Ramakesavan with Duquette.

Thus, claim 1 is patentable over Singleton, Ramakesavan, and Duquette because Singleton teaches away from claim 1, Ramakesavan teaches away from claim 1, and no suggestion exists to combine Duquette with Ramakesavan.

The Examiner argued that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Appellant respectfully traverses the Examiner's characterization of appellant's arguments as "attacking references individually" because appellant has argued that the references teach away from appellant's claimed invention and that no suggestion exists to combine the references because to do so would render Ramakesavan inoperable for its intended purpose.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Examiner argues "In response to applicant's argument that no particular piece of art matches claim 1, ..." Appellant respectfully traverse this characterization of appellant's argument because appellant does not argue that "no particular piece of art matches claim 1." Instead, appellant argues that references teach away from claim 1 and no suggestion exists to combine them because to do so would render Ramakesavan inoperable for its intended purpose.

The Examiner argues that "it is noted that the features upon which applicant relies (i.e., that you can see the PDA screen in the 'closed' position) are not recited in the rejected claims." Appellant respectfully traverses this characterization of appellant's argument because appellant does not argue that "you can see the PDA screen in the 'closed position'." Instead, appellant argues the language explicitly recited in the claim 1: "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display."

Claims 4, 6, and 23

Claims 4, 6, and 23 are dependent on claim 1 and are patentable over Singleton, Ramakesavan, Duquette for the reasons argued above.

2. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Chen (US Patent Publication Number 2004/0148419), hereinafter "Chen."

Claims 2 and 5 are dependent on claim 1 and are patentable over Singleton, Ramakesavan, and Duquette for the reasons argued above. In contrast to claim 1, Chen does not describe a personal digital assistant or one device connected to another via a hinge. Instead, Chen at Fig. 1 illustrates a computer 105 communicating via a wired or wireless connection to a device 110, as described by Chen at [0057], so Chen does not teach or suggest and teaches away from "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display," as recited in claim 1.

Thus, claim 1 and claims 2 and 5 (which depend on claim 1) are patentable over Singleton, Ramakesavan, Duquette, and Chen because Singleton teaches away from claim 1, Ramakesavan teaches away from claim 1, Chen teaches away from claim 1, and no suggestion exists to combine Duquette with Ramakesavan.

3. Claim 3 is rejected under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Hawkins (US Patent Number 6,957,397), hereinafter "Hawkins."

Claim 3 is dependent on claim 1 and is patentable over Singleton, Ramakesavan, and Duquette for the reasons argued above.

In contrast to claim 1, Hawkins at Fig. 1A and column 2, lines 60-67 describes a "handheld computer 100," which is not connected to a computer via a hinge and does not rotate, so Hawkins does not teach or suggest and teaches away from "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display," as recited in claim 1.

Thus, claim 1 and claim 3 (which depends on claim 1) are patentable over Singleton, Ramakesavan, Duquette, and Hawkins because Singleton teaches away from claim 1, Ramakesavan teaches away from claim 1, Hawkins teaches away from claim 1, and no suggestion exists to combine Duquette with Ramakesavan.

4. Claims 21-22 are rejected under 35 U.S.C. 103(a) over Singleton, Ramakesavan, Duquette, and Huber (US Patent Number 7,197,584), hereinafter "Huber."

Claims 21-22 are dependent on claim 1 and are patentable over Singleton, Ramakesavan, and Duquette for the reasons argued above.

In contrast to claim 1, the Huber "PDA 605 is placed into the indented space 615" of the PC chassis 600, as described by Huber at column 5, lines 23-27, and as illustrated by Huber at Fig. 6. Since the Huber PDA is placed into an indented space of a PC chassis, the Huber PDA is not attached via a hinge to the PC chassis and does not rotate, so Huber teaches away from "sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the

screen of the personal digital assistant is not viewable simultaneously with the computer display," as recited in claim 1.

Thus, claim 1 and claims 21-22 (which depend on claim 1) are patentable over Singleton, Ramakesavan, Duquette, and Huber because Singleton teaches away from claim 1, Ramakesavan teaches away from claim 1, Huber teaches away from claim 1, and no suggestion exists to combine Duquette with Ramakesavan.

Conclusion

Appellant respectfully requests reversal of the above rejections. If the Board is of the opinion that any rejected claim may be allowable in amended form, then appellant also respectfully requests a statement to that effect.

Respectfully submitted,

Date August 12, 2009 By

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Name Owen J. Gamon Signature

8. CLAIMS APPENDIX

1. A method comprising:

determining whether data meets a criteria;

if the data does not meet the criteria, sending the data to a computer display of a computer, wherein the computer comprises a base portion and a lid portion, wherein the base portion and the lid portion of the computer are attached via a first hinge, wherein the base portion and the lid portion of the computer rotate via the first hinge between a first closed position and a first open position, and wherein the lid portion comprises the computer display; and

if the data meets the criteria, sending the data to a personal digital assistant that is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side-by-side with the lid portion of the computer, wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display.

2. The method of claim 1, wherein the determining further comprises:

determining whether the data comprises an instant messaging application window.

3. The method of claim 1, wherein the determining further comprises:

determining whether the data comprises a calculator application window.

4. The method of claim 1, wherein the determining further comprises:

determining whether the data comprises a calendar application window.

5. The method of claim 1, wherein the determining further comprises:

determining whether the data comprises a media player application window.

6. The method of claim 1, wherein the determining further comprises:

determining whether the data comprises an e-mail application window.

21. The method of claim 1, further comprising:

instructing a power supply of the computer to supply power to an input device of the computer; and

receiving input at the personal digital assistant from the input device of the computer.

22. The method of claim 1, further comprising:

determining that data has been changed at the personal digital assistant;

determining whether the computer is powered on; and

if the data has been changed at the personal digital assistant and the computer is powered on, synchronizing the data with the computer.

23. The method of claim 1, further comprising:

sending input from an input device in the base portion to the personal digital assistant.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.